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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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04/20/2005

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EXAMINER

CANTELMO, GREGG

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

09/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/531,988	Applicant(s) EOM ET AL.	
	Examiner Gregg Cantelmo	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 1-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/26/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Preliminary Amendment

1. The preliminary amendment received April 20, 2005 has been entered. Claims 1-20 are pending.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement filed July 26, 2005 has been placed in the application file and the information referred to therein has been considered as to the merits. Note that the IDS erroneously lists the wrong US patent with the wrong inventor name. The references have been considered and are properly cited in the attached form PTO-892.

Specification

4. The disclosure is objected to because of the following informalities: the phrase Nickel-Metal Hybrid (page 1, line 13) should be Nickel-Metal Hydride.

Appropriate correction is required.

Claim Objections

5. Claim 1 is objected to because of the following informalities: the phrase "an portable" should be "a portable". Claims 2-20 fail to remedy this deficiency and are objected to for the same reasons. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2-20, the phrase "pen type fixing unit" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The term pen is more readily recognized in the electrochemical art as being a positive-electrolyte-negative arrangement. Use of the term pen in the claim and more so to the broader language of a pen "type" arrangement is unclear since it the claim fails to define the extent to which the fixing unit is a pen type construction nor does the application clearly define those structures which would be held to be a type of pen fixing unit. Applicant is advised to amend the term "pen type" to overcome this rejection. Claims 3-20 fail to remedy this deficiency and are rejected for the same reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-3 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,768,371 (Snyder).

Snyder discloses an external battery pack 15 comprising: a battery 40; an internal circuit (Figs. 3-7); a housing 15 having the secondary battery and the internal circuit; and an inserting portion formed in the housing, wherein the inserting portion is capable of inserting and fixing an portable electronic device 10 (Fig. 1 as applied to claim 1). The batteries discussed in Snyder are rechargeable, therefore one of ordinary skill in the art would readily envision the use of such in the system of Snyder.

The external battery pack further comprises a pen type 45 fixing unit having a holding part, the pen type fixing unit is formed at a rear side of the housing for being held on clothing or a belt (as applied to claim 2).

The assembly includes a connector, a charging circuit and an additional power source in the assembly for charging the portable electronic device (see Figs. 3-7 as applied to claim 6).

The housing includes ribs 56 in the housing (as applied to claims 3 and 14) and the device further includes a supporting portion on the front bottom side of the housing (as applied to claim 14).

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,136,229 (Galvin).

Galvin discloses an external battery pack 30 comprising: a battery; an internal circuit (Fig. 5); a housing having the secondary battery and the internal circuit; and an inserting portion formed in the housing, wherein the inserting portion is capable of

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inserting and fixing an portable electronic device 10 (Fig. 1 as applied to claim 1). The batteries discussed in Galvin and rechargeable, therefore one of ordinary skill in the art would readily envision the use of such in the system of Galvin. (as applied to claim 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder as applied to claim 2 above, and further in view of either U.S. Patent No. 5,903,132 (Ohira) or U.S. Patent No. 6,233,141 (Lee), or JP 07-038947 (JP '947).

The difference not yet discussed is of fixing hooks capable of moving in a vertical direction.

Use of vertical moving latch and release mechanisms are known in the art for mating power packs to a portable electronic device as shown by Ohira, Lee or JP '947. Note additionally that without definition of a plane of reference, the claimed vertical movement is relative to any plane or feature.

Selection of the particular manner in which the power supply connects to and detaches from the portable electronic device is held to be a matter of design choice and the configuration of such, in the absence of critical and unexpected results to the particular structure, would have been well within the skill of the ordinary worker in the art.

10. Claims 2, 6-11 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galvin as applied to claim 1 above, and further in view Snyder.

Galvin device includes a connector, a charging circuit and an additional power source in the assembly for charging the portable electronic device (see Fig. 5 as applied to claim 6). The system further includes a DC-DC voltage controller circuit and an output circuit (paras. bridging cols. 5 and 6 and col. 6, ll. 20-30 as applied to claims 7-10). A protection circuit is also provided (col. 5, ll. 20-30 as applied to claims 11 and 17-20).

Galvin does not disclose the pen type structure.

The use of pen belt clips to secure portable electronic devices onto objects such as a belt or strap is well known in the art as shown by Snyder.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Galvin to add a pen clip as taught by Snyder since it would have provided a configuration which permitted the portable electronic device to be held on a belt or strap and not be required to be hand-held by a user at all times.

11. Claims 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Galvin in view of Snyder as applied to claim 2 above, and further in view U.S. Patent No. 5,738,954 (Lantella).

Galvin device includes a connector, a charging circuit and an additional power source in the assembly for charging the portable electronic device (see Fig. 5). The system further includes a DC-DC voltage controller circuit and an output circuit (paras. bridging cols. 5 and 6 and col. 6, ll. 20-30). A protection circuit is also provided (col. 5, ll. 20-30 applied to claims 12 and 13).

Galvin does not teach of the display of claim 12.

The concept of providing a display which indicates the remaining power of a battery pack is well known in the art as shown by Lantella (col. 3, ll. 25-35).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Galvin to further include a battery remaining charge circuit and a display which indicates the remaining power in

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the battery since it would have improved the operation and efficiency of the portable electronic device and alerted the user to the power remaining in the battery in case the battery needs to be replaced or recharged.

Allowable Subject Matter

12. Claims 5 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: none of the prior art of record appear to reasonably teach, suggest or obviate the claimed detaching projecting portion of claim 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregg Cantelmo/
Primary Examiner, Art Unit 1795